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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/595,037

01/09/2006

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EXAMINER

KAVANAUGH, JOHN T

ART UNIT

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3728

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/595,037	Applicant(s) WARTEL ET AL.	
	Examiner /Ted Kavanaugh/	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-22 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-22 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1-9-2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 13,21,22,23,24 rejected under 35 U.S.C. 102(b) as being anticipated by US 2175962 (Kenifick).

Kenifick teaches a device (clasp 14) is integral part of the tongue (20) of the shoe. The device as shown in figures 1 covers the knot of the shoe but a partial loop of the lace can also be placed between the ends of the device and therefore the device is inherently capable of covering the loops. The device of Kenifick has all of the structure as claimed and therefore is inherently capable of performing all the functional language as claimed including being placed across the shoe so that the device is perpendicular to an axial direction of said shoe when the device is placed on the shoe. The shoe is only functionally being claimed.

3. Claims 13-16,18,21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5042119 (Williams).

Williams teaches a device (170,180; see figure 8) comprising mutual self gripping means (VELCRO), equivalent means for fixing the band to the shoe (apertures 92), a series of orifices (24) for the laces to pass. The device is laced to the tongue and

Art Unit: 3728

therefore is an integral part of the tongue. The device of Williams has all of the structure as claimed and therefore is inherently capable of performing all the functional language as claimed including being placed across the shoe so that the device is perpendicular to an axial direction of said shoe when the device is placed on the shoe. The shoe is only functionally being claimed. The device of Williams is shown covering the whole loops of the shoe lace but longer shoe laces can be used with would extend beyond the device of Williams.

4. Claims 13,14,15 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6338186 (Kleinmann).

Kleinmann teaches a device (10,10') in the form of a band arranged to cover the laces (see figure 3), means for fixing the band to the shoe (see col. 5, lines 10-18), and a series of orifices (15,1,6,17,18) for the lace to pass through. The device of Kleinmann has all of the structure as claimed and therefore is inherently capable of performing all the functional language as claimed. The shoe is only functionally being claimed. Moreover, see figure 1 which shows the device placed on the shoe having a length being substantially perpendicular to an axial direction of said shoe.

5. Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by US 6338186 (Kleinmann).

Kleinmann teaches in combination a shoe (20) and a device (10,10') in the form of a band arranged to cover the laces (see figure 3), the device has a left hand end and a right hand end comprising mutual fixing means (latch 14, see col. 2, lines 66 to col. 3, line 2), means for fixing the band to the shoe (see col. 5, lines 10-18), and a series of

Art Unit: 3728

orifices (15,1,6,17,18) for the lace to pass through. See figure 1 which shows the device placed on the shoe having a length being substantially perpendicular to an axial direction of said shoe.

6. Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by US 5042119 (Williams).

Williams teaches a shoe and a device (170,180; see figure 8) comprising mutual self gripping means (VELCRO), equivalent means for fixing the band to the shoe (apertures 92), a series of orifices (24) for the laces to pass. The device is laced to the tongue and therefore is an integral part of the tongue. See figures 6 and 8 of Williams which shows the device placed on the shoe having a length being substantially perpendicular to an axial direction of said shoe.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over either references: Williams '119 and Kleinmann '186.

Williams and Kleinmann both teach a series of orifices (see the rejection above) except for the specific arrangement of orifices as claimed in claim 17. It would be an obvious design choice to provide the device of either Williams or Kleinmann with any combination of orifices including slits and circular orifices inasmuch as

any such combination appears to be merely a design choice. This view is buttressed by applicant disclosure which show a plurality of different combination of orifices (see figures 1-9) and none of which provide a new or unexpected result.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over either reference: Kleinmann '186 or Kenifick '962.

Both patents teach a device as claimed except for the specific dimensions as claimed. It would be an obvious design choice to construct the device with the dimensions as claimed inasmuch as a plurality of different dimensions appear to be suitable and the specific dimensions don't appear to provide any new or unexpected results.

Response to Arguments

10. Applicant's arguments filed 7-8-2008 have been fully considered but they are not persuasive.

Applicant argues "the device of Kenifick does not have a left-hand end and a right hand end, each comprising mutual fixing means but, rather, upper and lower ends."

In response, the device of Kenifick has two ends and the ends could be labeled upper/lower ends or first/second ends or left/right ends. Merely, labeling the two ends of the device differently doesn't show any structural distinction.

Applicant argues "the device according to Kenifick is not designed to be folded down in the closed position by fixing the left hand end to the right hand end"

In response, as noted in the response to the first argument above the device does have a left hand end and a right hand end. The ends are fold in a closed position as shown in figure 4 and are fixed at the ends; see reference numeral #42 in figure 4.

Applicant argues "Kenifick fails to disclose that the length of said device is perpendicular to an axial direction of said shoe, when said device is placed thereon".

In response, the device of Kenifick has all of the structure as claimed and therefore is inherently capable of performing all the functional language as claimed including being placed across the shoe so that the device is perpendicular to an axial direction of said shoe when the device is placed on the shoe. The shoe is only functionally being claimed.

Applicant argues the device is moreover not designed to only partially cover the loop but to clamp the knot.

In response, the device is inherently capable of being covering the loop of the shoe laces. The shoe is only functionally being claimed.

Applicant argues that the device of Williams is a pocket and not a band as claimed.

To the contrary, the term "band" is a very broad term which would include the device of Williams inasmuch as the device is a thin, flat strip of some material.

Applicant argues Williams fails to disclose that the length of said device is perpendicular to an axial direction of said shoe, when said device is placed thereon.

In response, the device of Williams has all of the structure as claimed and therefore is inherently capable of performing all the functional language as claimed

including being placed across the shoe so that the device is perpendicular to an axial direction of said shoe when the device is placed on the shoe. The shoe is only functionally being claimed. Moreover, the device of Williams when placed on the shoe does have a length as claimed; see figure 6.

Applicant argues that the device of Kleinmann is not in the form of a band.

In response, Kleinmann teaches the device can ovalized and flattened rather than circular; see col. 4, lines 40-42 and therefore the device is a thin, flat strip of some material.

Applicant argues that the device of Kleinmann does not a series of orifices in a central part but instead the orifices are in the left hand end.

To the contrary, the central part of the device would be the whole entire region between the ends of the device and therefore the orifices are shifted off center but nonetheless they are located in the central part of the device.

11. Applicant's arguments with respect to claim 25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (In United States OR CANADA) or 571-272-1000.

/Ted Kavanaugh/
Primary Examiner
Art Unit 3728

TK
August 1, 2008

Application/Control Number: 10/595,037
Art Unit: 3728

Page 10